



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: H. Wurster et al.

Application No.: 09/940,805

Title: Integrated Decorator Coupler and Food Decorating Assembly

Filing Date: August 29, 2001

Art Unit: 1761

Examiner: S. Weinstein

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Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

SIR:

Applicants request review of the final rejection of July 26, 2006 in the above-identified application. A notice of appeal is being filed concurrently with this request. This review is requested for the reasons stated below.

REMARKS

Summary of Invention

The present claims recite an integrated coupler, *i.e.* a coupler that has a decorative opening designed to extrude filling in a decorative shape and that is attachable to a decorative tip for extruding filling in another decorative shape.

Summary of Rejection

Claims 1-12 and 14-20 are pending in the present application. All these claims stand rejected under 35 U.S.C. 103(a) as being allegedly rendered obvious by U.S. Patent No. 6,153,238 to Shannon ("Shannon") in view of GB 2,237,224 to Craig; U.S. Patent No. 3,191,809 to Schultz; U.S. Patent No. 2,103,111 to Ekdahl; U.S. Patent No. 2,968,262 to Lacey; U.S. Patent No. 2,945,458 to Setecka; U.S. Patent No. 560,719 to Hueg and further in view of EP Patent No. 757006 to Ooms; FR Patent No. 598,674 to Berrod; U.S. Patent No. 3,847,523 to Parrish; U.S. Patent No. 2,320,496 to Wechsler; U.S. Patent No. 4,844,917 to DeLorimere; U.S. Patent No. 2,419,654 to Moore; U.S. Patent 6,179,165 to Knight; and U.S. Patent Publication 2003/0205584 to Niggemyer.

The Office Action states that "it would have been obvious to provide a non-circular decorative tip with means to accept and secure other decorative tips to provide the user with greater choice of designs" or "it would have been obvious to modify the circular outlet coupler, which already has a means to accept and secure decorative tips, by providing a non-circular outlet." Office Action dated July 26, 2006, p. 2.

Summary of Arguments in Response to Rejection

Applicants submit that there is no motivation to modify the circular coupler opening of Shannon with a non-circular decorative opening because the use of a non-circular decorative opening runs counter to the intended purpose of Shannon's coupler. The courts have held that there is no motivation to modify a reference when the suggested combination of references would require "a change in the basic principle under which the [primary reference] construction was designed to operate." *In re Ratti*, 270 F. 2d 810, 813, 123 USPQ 349, 352 (CCPA 1959).

Shannon's coupler, like all of the couplers in the other cited references, shows a large circular opening. (As used herein, a "large" circular opening means an opening on a coupler that is larger than the decorative opening of an attached tip). The primary purpose, if not the only purpose, of the opening of the couplers in the cited art is to allow filling (such as icing) to flow from a bag, through the opening and through an attached decorative tip with a minimum amount of effort by the user. To minimize the resistance to the flow of the filling through the device, the basic laws of fluid dynamics requires the opening of the coupler to be circular and requires the opening of the coupler to be the same size or larger than the decorative opening of the tip. *See* Wurster Declaration, filed April 25, 2006, paragraph 4.

Accordingly, the couplers cited by the examiner always describe large circular openings. This indicates that the design of their couplers is dictated by the desired function of allowing filling to flow to a tip with a minimum amount of resistance. For example, referring to Exhibit A, the diameter D of the adapter 141 of Shannon shown in FIG. 5 is larger than the diameter d the decorative tip 40 shown in FIG. 4. (The designations "D" and "d" have been added by Applicants for identification purposes). Nothing in any of the cited references suggests that the couplers could have non-circular openings.

The use of a non-circular decorative opening as recited in claim 1, for example, necessarily increases the amount of resistance of the opening, thereby running counter to the intended purpose of the couplers of the prior art. Thus, there is no motivation for one of ordinary skill in the art to modify the circular openings of the prior art couplers to a non-circular decorative shape.

In addition, the Office Action identifies no motivation for one of skill in the art to take a first decorative tip, such as that shown in Figure 7 of Shannon, and modify it to allow it to accept a second decorative tip on top of the first decorative tip.

The following dependent claims are patentable for the reasons discussed above. They contain additional limitations that further distinguishes them from the cited art.

Claims 7 and 12 each recite a second decorative tip.

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Claim 11 recites a method of decorating food comprising, inter alia, pushing filling through the non-circular opening of a coupler, which is not taught or suggested by Shannon.


Claims 16 and 17 recite a coupler having a decorative tip including dentate protrusions.

CONCLUSION

In view of the foregoing, the Examiner erred in finally rejecting claims 1-12 and 14-20. Accordingly, favorable action on this Pre-Appeal Brief Request for Review is respectfully requested.

Respectfully submitted,
KENYON & KENYON LLP

Dated: 9-26-06


By: Zeba Ali
(Reg. No. 51,392)

1500 K Street, N.W.
Suite 700
Washington, D.C. 20005
Tel: (202) 220-4200
Fax: (202) 220-4201
NY01 1239310

